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Paper No. 20

In re Application of
John F. Acres
Application No. 09/694,065
Filed: October 19, 2000
Attorney Docket No. 4164-158

: DECISION ON PETITION

This is a decision on the petition filed on May 17, 2004, by which petitioner seeks supervisory review of the examiner's action in dismissing petitioner's appeal for repeatedly failing to file an appeal brief in compliance with 37 CFR 1.192(c), and thereafter holding that this application stands abandoned as a result of the dismissal of the appeal and the absence of any allowed claims in the application. The petition is being considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is denied.

The record shows that following the promulgation of a final rejection on June 27, 2003, petitioner filed a Notice of Appeal and then, on February 3, 2003, petitioner filed an appeal brief. On May 19, 2003, the examiner advised petitioner that the appeal brief was defective because it filed to comply with 37 CFR 1.192(c)(7). That subsection of the regulation governs the treatment of a ground of rejection applied to more than one claim, and requires that if such a ground of rejection exists, an appellant state whether the some or all of the claims rejected on that ground "stand or fall together", and also that if it is stated that some or all of the claims so rejected do not "stand or fall together", that an appellant supply argument(s) in support of that statement.[1] The record also shows that in this action, the examiner provided petitioner with specific examples explaining the examiner's position.[2]

In response, petitioner filed a substitute appeal brief on June 19, 2003. The examiner then promulgated a new final rejection, and petitioner then requested that the appeal be reinstated and filed a new appeal brief.[3] The examiner held the newly filed appeal brief to be defective, again for failure to comply with 37 CFR 1.192(c)(7), citing 37 CFR 1.192(d) as a basis for so doing and noting that this subsection of the regulation does not give the examiner any discretion.[4] It is apparent that the examiner took the view that the Notification of Non-Compliance with 37 CFR 1.192(c) originally mailed on May 19, 2003 triggered the application of 37 CFR 1.192(d) when the appeal brief subsequently filed on December 3, 2003 failed to comply with 37 CFR 1.192(c)(7).

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[1] 37 CFR 1.192(c)(7) states: "For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable."

[2] See paper No. 13, items 6(a), 6(b) and 9.

[3] See 37 CFR 1.193, and paper Nos. 15 and 16 in the record.

[4] 37 CFR 1.192(d) states: "If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed."

On pages 3-9 of the petition, petitioner has set forth various arguments supporting petitioner's requested relief. None of these arguments are persuasive. Particularly telling is the argument presented beginning with the last paragraph appearing on page 5 of the petition. In that argument, petitioner states that:

> "[A]ppellant is unaware of any requirement in the Code of Federal Regulations or the MPEP that provides that the Examiner's categories of rejections must be set forth verbatim as the grouping of claims or that the Examiner's categories of rejections cannot be subdivided to form groups. That the Appellant is required to group the claims in the brief implies that the Appellant has some control over how the claims are grouped, at least to the extent the groups are comprised of two or more claims for each ground of rejection appellant contests."

This argument implies that petitioner simply does not comprehend the requirements of 37 CFR 1.192(c)(7), notwithstanding that the examiner clearly explained these requirements in paper No. 13, dated May 19, 2003, that the regulation seems to be quite explicit, and that MPEP § 1206 provides a detailed and cogent explanation of the requirements of this subsection of the regulation. 37 CFR 1.192(c)(7) quite clearly and specifically defines a plurality of claims that have been rejected on a given ground of rejection as being a "grouping of claims." There is **no** discretion available to an appellant with respect to determining the "grouping(s) of claims"; if the examiner rejects claims A, B, D and X as being anticipated by the patent to Jones under 35 USC 102, then anticipation by the patent to Jones **is** a ground of rejection, and claims A, B, D and X **are** the members of the "grouping of claims" rejected on that ground. The sole discretion that an appellant has is to state for the record which of the claims, if any, within that "grouping of claims" is deemed to be separately patentable from any of the other claims in that "grouping of claims." If appellant does state that one or more claims within that "grouping of claims" is separately patentable apart from the other claims in that "grouping of claims", then appellant is **required**[5] to provide argument(s) explaining why that the one or more claims is separately patentable from the other claim(s) in that "grouping of claims."

None of the other arguments presented by petitioner are persuasive that the examiner's action in this application is either arbitrary or capricious, or amounts to an abuse of discretion. For example, the argument in the first sentence on page 6 of the petition that " ... the Examiner has not identified the different categories of rejection as constituting groups" ignores the fact that it is the regulation itself that so defines matters. Even if some of the arguments advanced by petitioner might be deemed to be persuasive as to a single claim or a single claim grouping, it is clear that taken as a whole, the appeal brief filed on December 3, 2003 did not comply with 37 CFR 1.192(c)(7). As the record shows that the appeal brief filed on February 3, 2003 also had failed to comply with 37 CFR 1.192(c)(7), and that petitioner was seasonably so notified, it appears that the examiner's action was proper pursuant to 37 CFR 1.192(d). Therefore, there is no basis for granting any of the relief requested.

Petitioner is entitled to request reconsideration of this decision, provided that the request for reconsideration is filed within two months of the date of this decision. The failure to establish a basis for relief pursuant to 37 CFR 1.181 would imply that petitioner's remedy would lie with 37 CFR 1.137.

PETITION DENIED.

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[5] Again, there is no discretion here.